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Hiroshi Sasaki

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EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT

PAPER NUMBER

3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/813,033	Applicant(s) SASAKI ET AL.	
	Examiner C. Michelle Tarae	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to the communication filed on September 4, 2007.

Claims 31, 33, 36 and 39-41 have been amended. Claims 31-34 and 36-43 are now pending in this application.

Response to Amendment

2. The amendment to claims 31, 33, 36 and 39-41 is acknowledged.

Response to Arguments

3. Applicant's arguments have been fully considered, but are found unpersuasive. In the Remarks Applicant argues the following:

1) that Wilz, Sr. et al. does not specifically disclose what information is tracked and managed (page 8 of Remarks);

2) that Naftzger and Wilz, Sr. et al. are not properly combinable to achieve the structure of the claimed present invention (page 9 of Remarks); and

3) that Wilz, Sr. et al. does not disclose the newly added limitation of a two-dimensional optically readable coded image (page 9 of Remarks).

In response to argument 1), Examiner respectfully disagrees. Additionally, it is not clear what specific limitation Applicant is referring to. Thus it appears that Applicant is arguing limitations not recited in the rejected claim(s). For example, a scan of all the

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claims does not result in any limitations dealing with tracking and managing information. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to argument 2), Examiner respectfully disagrees. As discussed in the rejection, Wilz, Sr. et al. and Naftzger are analogous in that each is concerned with uniquely identifying and tracking the distribution of printed matter using codes associated with the printed matter. Wilz, Sr. et al. uniquely identifies and tracks the distribution of printed matter using codes associated with the printed matter as discussed in at least col. 31, lines 30-57. Naftzger uniquely identifies and tracks the distribution of printed matter using codes associated with the printed matter as discussed in at least col. 16, lines 12-26. Further, Wilz, Sr. et al. uses two-dimensional URL encoded bar codes to facilitate the tracking of documents (col. 7, lines 35-38, col. 14, lines 15-18 and Figure 1C(2)); and Naftzger uses the codes to determine the success of advertisements by comparing user interest to the advertisements in different printed matter (col. 15, lines 50-62; col. 16, lines 12-26). Accordingly, Examiner respectfully submits that Wilz, Sr. et al. and Naftzger are analogous enough to achieve a reasonable expectation of success upon their combination.

In response to argument 3), Examiner respectfully disagrees. Col. 7, lines 35-38, col. 14, lines 15-18 and Figure 1C(2) disclose an example of a 2-D (two-dimensional) URL encoded bar code.

In conclusion, Applicant's arguments have been fully considered, but are found unpersuasive. The rejections are provided below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. (U.S. 6,152,369) and Naftzger (U.S. 5,717,866).

As per claim 31, Wilz, Sr. et al. discloses a marketing research comprising:
distributing a plurality of copies of a plurality of different types of printed matter each marked with a two-dimensional optically readable coded image encoding ID information and a URL specifying an information resource on the Internet (col. 5, lines 19-29; col. 6, lines 57-67; col. 7, lines 35-38; col. 14, lines 15-18; col. 23, lines 43-55; col. 24, lines 6-21; col. 31, lines 47-51; Figure 7A; Printed matter is distributed such as books, journals, magazines, etc. The printed matter includes URL-encoded bar codes

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that point to information resources on the Internet. The URL-encoded bar code also includes ID information such as title and description. The URL-encoded bar code also supports document tracking and delivery where each printed document is uniquely identified. Figure 1C(2) illustrates an example of a 2-D (two-dimensional) URL encoded bar code.),

obtaining ID information identifying respective copies of the printed matter and access information for each access to the information resource responsive to an operation of: (i) optically reading with a reading device the two-dimensional optically readable coded image provided on the printed matter, (ii) restoring the URL and the ID information from the read coded image, and (iii) accessing the information resource corresponding to the restored URL via an access device which is connected to the reading device (col. 5, lines 39-53; col. 18, lines 44-67; When a URL-encoded bar code is read, it identifies the location of the information resource on the Internet, restores it and directs a user to the correct URL for access.); and

storing the restored ID information and the access information (col. 31, lines 41-47; Figure 11B; Document ID, tracking and delivery (i.e., access) information is stored and maintained.).

Wilz, Sr. et al. does not expressly disclose wherein each of the plurality of different types of the printed matter includes a same advertisement, wherein the two-dimensional optically readable coded image is printed so as to correspond to each advertisement of each of the plurality of different types of the printed matter, and

wherein the ID information includes at least one of a title and type of the printed matter and information identifying the advertisement contained in the printed matter.

Naftzger discloses wherein each of the plurality of different types of the printed matter includes a same advertisement, wherein the a two-dimensional code is printed so as to correspond to each advertisement of each of the plurality of different types of the printed matter, and wherein the ID information at least one of a title and type of the printed matter and information identifying the advertisement contained in the printed matter (col. 15, lines 50-62; Promotional codes are used to identify the same advertisement for a product discount on different distribution materials.). Wilz, Sr. et al. and Naftzger are analogous in that each is concerned with uniquely identifying and tracking the distribution of printed matter using codes associated with the printed matter. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Wilz, Sr. et al. to have the code identify the same advertisement but different types of printed matter because doing so facilitates the tracking of the different advertisement distribution means (i.e., track uniquely an advertisement running in a daily newspaper versus the same advertisement running in a weekly entertainment magazine as disclosed by Naftzger in col. 15, lines 53-56), which helps to compare the advertising effectiveness of each advertisement distribution means.

Wilz, Sr. et al. does not expressly disclose producing a marketing research report utilizing the stored ID information and the stored access information, wherein said marketing research report compares interest taken by users of the plurality of different types of the printed matter in the same advertisement.

Naftzger discloses producing a marketing research report utilizing the stored ID information and the stored access information, wherein said marketing research report compares interest taken by users of the plurality of different types of the printed matter in the same advertisement (col. 16, lines 12-24). Wilz, Sr. et al. and Naftzger are analogous in that each is concerned with uniquely identifying and tracking the distribution of printed matter using codes associated with the printed matter. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Wilz, Sr. et al. to produce a marketing research report utilizing the stored ID information and the stored access information, where the marketing research report compares interest taken by users of the plurality different types of the printed matter in the same advertisement in order to track the effectiveness of the printed materials in causing an individual to react in a certain way (i.e., redeem a product discount) to the advertisements distributed on the printed materials, thereby enhancing the usefulness of the marketing strategy.

As per claim 32, Wilz, Sr. et al. discloses the marketing research method wherein the URL includes the ID information (col. 5, lines 19-29; col. 17, line 60-col. 18, line 14; col. 31, line 41-col. 32, line 6; The printed matter is identified by the URL. A document tracking and delivery server uniquely identifies each document via the URL.).

As per claim 33, Wilz, Sr. et al. discloses the marketing research method wherein the two-dimensional optically readable coded image further comprises a browser starting program for starting a browser in the access device (col. 6, line 57-col. 7, line

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24; The bar code symbol may be encoded with a URL as well as with instructions for starting a browser program.).

As per claim 34, Wilz, Sr. et al. discloses the marketing research method wherein the plurality of different types of the printed matter includes a newspaper, a magazine, a book, a journal, a pamphlet, a catalog, a leaflet, a business card and a ticket (col. 23, lines 47-60; Printed matter may include books, journals, magazines.).

As per claim 36, Wilz, Sr. et al. discloses the marketing research method wherein the information resource is an information resource belonging to an issuer of the printed matter (col. 23, lines 47-67; col. 24, lines 3-26; The composer of the URL encoded images may be the writer of the book and the information resource may be their product/service website. The composer of the URL encoded images may identify any information resource they desire.).

As per claim 37, Wilz, Sr. et al. discloses the marketing research method wherein the information resource is an information resource belonging to a sponsor of the advertisement (col. 34, lines 4-18; The URL encoded images may link to advertisements as well as to other marketing-related information belonging to the sponsor of the advertisement/ marketing-related information.).

As per claim 38, Wilz, Sr. et al. discloses the marketing research method wherein the access information on the accesses to the information resource includes at least one of a number of accesses, date and time of each of the accesses and data on each person who accessed the information resource (col. 31, lines 30-67; Figures 7A, 7B and

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11B; A document tracking and delivery system is used to track access to the printed matter.);

As per claim 39, Wilz, Sr. et al. discloses the marketing research method wherein the two-dimensional optically readable coded image includes information on at least one of a sound, an image and a text in addition to said URL (col. 31, lines 6-29; The coded images may include multi-media, such as audio-visual messages.).

Claims 40-43 recite limitations similar to the limitations already rejected above in claims 31-39. Therefore, claims 40-43 are rejected on the same basis as claims 31-39 above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


C. MICHELLE TARAE
PRIMARY EXAMINER

October 30, 2007